

REMARKS

Entry of the foregoing, re-examination and reconsideration of the subject matter identified in caption, as amended, pursuant to and consistent with 37 C.F.R. §1.112, and in light of the remarks which follow, are respectfully requested.

Claims 44 and 45 have been amended to specify that the ratio of total true dimer units (i.e. compounds of general formula X; page 17 and page 20, lines 11-12) to isocyanate functions is $\leq 30\%$. Support for this feature may be found on page 20, lines 2-6 of the specification. Claims 39-42 have been amended in response to §112 issues raised in the Office Action. Claims 39-49 remain pending in this application.

Claims 39-43 were rejected under 35 U.S.C. §112, first paragraph, as non-enabling and lacking a written description for the reasons set forth in paragraphs (1) and (2) of the Office Action. Reconsideration and withdrawal of these rejections are respectfully requested for at least the following reasons.

Claims 39-43 are directed to processes for producing a low-viscosity polyfunctional isocyanate composition containing (1) at least one isocyanate trimer having an isocyanurate unit, or a compound containing a biuret unit or mixtures thereof, and (2) at least one isocyanate dimer containing a uretidinedione unit. The specification refers to a process of producing the aforementioned compositions (page 14, line 35 to page 15, line 3). Originally filed claims 7-10 also described the preparation of compositions containing an isocyanate trimer having an isocyanurate unit and/or a compound containing a biuret unit, and an isocyanate dimer. Clearly, the original disclosure reasonably conveys to those skilled in the art that the inventors had possession of the claimed subject matter (M.P.E.P. §2163.02). Thus,

the disclosure provided a written description of the invention of claims 39-43 sufficient to satisfy the written description requirement of §112, first paragraph.

With regard to the enablement issue, Applicants note that the Examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention. *In re Wright*, 999 F.2d 1557, 27 U.S.P.Q.3d 1510 (Fed. Cir. 1993). In fact, a specification disclosure which contains a teaching of the manner and process of making and using an invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented must be taken as being in compliance with the enablement of 35 U.S.C. §112, first paragraph, unless there is a reason to doubt the objective truth of the statements contained therein which must be relied on for enabling support. See M.P.E.P. §2164.04 and *In re Marzocchi*, 439 F.2d 220, 169 U.S.P.Q.367 (CCPA 1971).

The first paragraph of 35 U.S.C. §112 merely requires that the specification enable one skilled in the art to make and use the invention without undue experimentation. See *In re Borkowski*, 164 USPQ 642 (CCPA 1970). A detailed description or working example of every possible embodiment falling within a particular claim simply is not (nor has it ever been) a requirement of the first paragraph of 35 U.S.C. §112. The breadth of the claims is irrelevant so long as they set forth an invention which is described in the specification such that one skilled in the art can make and use the invention.

With the above principles in mind, Applicants respectfully submit that the scope of enablement in the present application is commensurate in scope with the claims when considered as a whole. Those skilled in the art would be able to

practice the claimed invention given the information in the disclosure coupled with the level of knowledge and skill in the art. The scope of enablement only needs to bear a "reasonable correlation" to the scope of the claims. Thus, in order to sustain a non-enablement rejection under 35 U.S.C. §112, first paragraph, the burden is on the Examiner to provide cogent reasons why those of ordinary skill in the relevant art would not be able to practice the invention defined by the claims based on a review of the specification coupled with the technical knowledge possessed by the routineer in the art. Applicants respectfully submit that the entire specification and the working examples when coupled with the technical knowledge possessed by those of ordinary skill in this art clearly enables those of ordinary skill to practice the presently claimed invention.

The rejection states on page 2: "It is not clear that the same methods or catalysts that will yield isocyanurates will yield biurets." The instant specification discloses processes for producing the compositions set forth in the claims. Example 1 on page 32 and Example 3 on page 33 of the specification disclose processes which produce compositions containing a biuret compound and an isocyanate dimer. Example 12 on page 39 also discloses the preparation of a composition comprising a biuret and an isocyanate dimer. This disclosure, coupled with the knowledge of those skilled in the art, is sufficient to satisfy the enablement requirement of the statute.

Accordingly, the §112, first paragraph, rejections should be reconsidered and withdrawn.

Claims 39-43 and 45-49 were rejected under 35 U.S.C. §112, second paragraph, for the reasons provided in paragraph (3) of the Office Action.

Withdrawal of this rejection is requested in view of the above amendments and the following comments.

The misspelling of "isocyanate" in claim 45 has been corrected. Antecedent basis has been provided in claims 39-42 for the words "the starting reaction medium," "the reaction product" and "the starting monomers." Claims 39-42 have been amended to specify that reaction takes place in the presence of catalyst. However, Applicants note that the added language does not preclude reaction between the reactants and the catalyst.

In view of the above, the §112, second paragraph, has been obviated and should be withdrawn.

Claims 44-49 were rejected under 35 U.S.C. §103(a) as unpatentable over U.S. Patent No. 5,663,274 to Lee et al. for reasons set forth in paragraph (5) of the Office Action. Withdrawal of this rejection is respectfully requested in view of the above amendments and for at least the following reasons.

Lee et al. '274 discloses the reaction of polyisocyanates containing a uretdione group with compounds containing at least two isocyanate reactive groups to form reaction products having cyclic groups containing urea and/or urethane groups. Polyisocyanate adducts containing biuret groups may be present according to the disclosure in column 4, lines 36-62. No further details are mentioned.

Claims 44-49, as amended, now specify that the biuret function represents at least 10% by weight of the composition and that the true dimer/isocyanate function ratio is $\leq 30\%$. Lee et al. '274 does not disclose compositions containing biuret functions of at least 10% by weight. Also, in the polyisocyanate reactants, the uretdione group content must be 1 to 30% based on the weight of polyisocyanate

component (column 1, line 61). Clearly, the compositions of claims 44-49 are not disclosed or suggested by Lee et al. '274.

For at least the above reasons, the §103(a) rejection should be withdrawn. Such action is respectfully requested.

Claims 44-49 were provisionally rejected on the ground of obviousness double patenting over claims 66-68 and 73-76 of copending application, Serial No. 09/485,533. The Examiner's reasons are set forth in paragraph (7) of the Office Action.

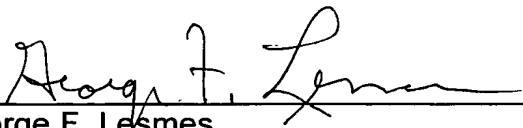
The claims in Serial No. 09/485,533 have been amended to exclude the mixtures claimed herein. Accordingly, it is requested that this rejection be reconsidered and withdrawn.

From the foregoing, further and favorable action in the form of a Notice of Allowance is believed to be next in order and such action is earnestly solicited. If there are any questions concerning this paper or the application in general, the Examiner is invited to telephone the undersigned at (703) 838-6683 at his earliest convenience.

Respectfully submitted,

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